

REMARKS

The above-identified application has been reviewed in light of the Office Action mailed on September 28, 2009. By the present amendment, the Applicants have amended claims 1 and 19. It is respectfully submitted that the pending claims are fully supported by the specification, introduce no new matter, and are allowable over the references of record.

The Applicants would like to thank Examiner Yabut for the courtesies extended to the Applicants' representative, Dana A. Brussel, Esq., during the telephone interview conducted on October 27, 2009. During the interview, Examiner Yabut and the Applicants' representative discussed the differences between the pending claims and one of the cited references. Additionally, Examiner Yabut and the Applicants' representative discussed proposed amendments to the independent claims that would clarify the structural relationships of the claimed device. The Applicants have incorporated Examiner Yabut's helpful suggestions into the amended claims.

In the Office Action, claims 1, 6-9, 11, 14, 16, and 19-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. Re 28,932 to Noiles et al. ("Noiles"). According to the Office Action, Noiles discloses all the features recited in claims 1, 6-9, 11, 14, 16, and 19-24. The Applicants respectfully disagree and traverse the rejection for the reasons detailed below.

As amended, claim 1 recites an applicator including, *inter alia*, an outer tube, an actuator, a fastener, and a rotator, wherein "actuation of the actuator results in rotation and translation of the at least one fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube." Similarly, claim 19 recites an applicator having, *inter alia*, an outer tube, an actuator, a fastener, and a rotator, wherein "actuation of the actuator

results in rotation and translation of each fastener of the plurality of fasteners relative to the outer tube and the rotator remains axially stationary with respect to the outer tube."

In contrast, as seen below in Figures 19 and 21, Noiles relates to a surgical instrument having a pair of drive screws 218 that rotate and a plurality of staples 208. Each staple 208 includes a cross bar 210 that extends transversely to a longitudinal axis of the surgical instrument.

Fig. 19.

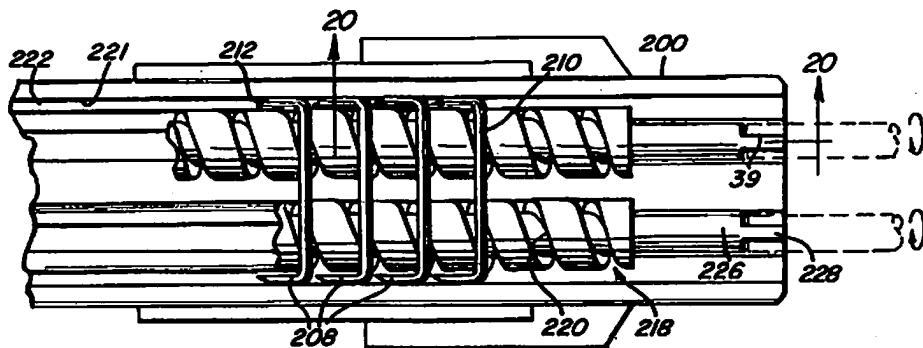
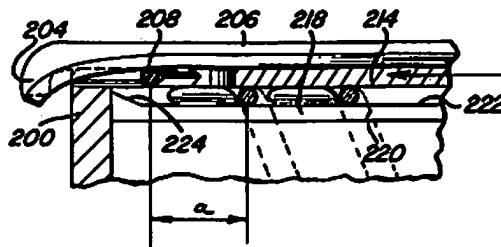


Fig. 21



As drive screws 218 rotate, staples 208 advance distally. Further still, as staples 208 advance distally, cross bars 210 remain transverse to the longitudinal axis of the surgical instrument since points 212 of staples 208 remain within ledges 222 of cartridge 26 as staples 208 are advanced distally through cartridge 26. Staples 208 are not capable of rotating relative to the cartridge. Thus, Noiles fails to anticipate or suggest an actuator that "results in rotation and translation of the at least one fastener" as recited in amended claim 1 and an actuator that "results in rotation and translation of each fastener" as recited in amended claim 19. Therefore,

Appl. No. 10/755,427

Amendment dated October 27, 2009

Reply to Office Action Mailed September 28, 2009

it is respectfully submitted that amended independent claims 1 and 19 are neither anticipated nor suggested by Noiles and are in condition for allowance. Since claims 6-9, 11, 14, 16, 23, and 24 depend from independent claim 1 and claims 20-22 depend from independent claim 19, it is respectfully submitted that these claims are also in condition for allowance.

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being obvious over Noiles in view of U.S. Patent No. 4,596,350 to Smith et al. (“Smith”). According to the Office Action, Noiles discloses the applicators recited in claims 2 and 3 except for a lock/clip indicator and a load spring. The Office Action stated that Smith discloses a lock/clip indicator for engaging a plurality of fasteners from the applicator and a load spring for applying longitudinal forces against the lock/clip indicator and that it would be obvious to provide Noiles with the lock/clip indicator and load spring of Smith.

As previously discussed, Noiles does not disclose or suggest the applicator recited in claim 1. Adding the lock/clip indicator and load spring of Smith to Noiles fails to cure the deficiencies of Noiles. Smith fails to disclose or suggest any additional features that, in combination with Noiles, suggest the applicator recited in claims 2 and 3. Since claims 2 and 3 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Noiles in view of U.S. Patent No. 4,628,943 to Miller (“Miller”). The Office Action stated that Noiles disclosed the claimed device except for the terminal end having a thread with an interlock spring and relied on the disclosure of Miller to provide the missing features.

As discussed in detail hereinabove, Noiles fails to disclose or suggest the applicator recited in claim 1. Adding the terminal end with a thread and an interlock spring as disclosed in

Appl. No. 10/755,427
Amendment dated October 27, 2009
Reply to Office Action Mailed September 28, 2009

Miller fails to cure the deficiencies of Noiles. Miller fails to disclose or suggest any additional features that, in combination with Noiles, suggest the applicator recited in claims 4 and 5. Since claims 4 and 5 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 10, 15, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noiles. The Office Action asserted that Noiles discloses the claimed device except for the lead screw being a high helix lead screw and the fasteners being formed from an absorbable material. As discussed hereinabove, Noiles fails to disclose or suggest the applicator recited in independent claims 1 and 19. In particular, Noiles fails to disclose or suggest that actuation of the actuator results in “rotation and translation” of the fasteners. Substituting a high helix lead screw for the lead screw of Noiles fails to cure this deficiency. Similarly, forming the fasteners of Noiles from an absorbable material fails to cure the above-noted deficiencies of Noiles. Since claims 10, 15, and 25 depend from claim 1 and claim 26 depends from claim 19, it is respectfully submitted that claims 10, 15, 25, and 26 are in condition for allowance.

The Office Action rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Noiles in view of U.S. Patent No. 5,487,500 to Pratt et al. (“Pratt”). The Office Action stated that Noiles discloses the applicators recited in claims 12 and 13 except for gear teeth formed within the interior of the handle and a spring loaded pawl adapted to engage gear teeth. The Office Action relied on the disclosure of Pratt to provide the missing features. However, as previously discussed, Noiles fails to anticipate or suggest the applicator recited in claim 1. Adding the gear teeth and the spring loaded pawl of Pratt fails to cure the deficiencies of Noiles. Pratt fails to provide any disclosure or suggestion that, in combination with Noiles, would suggest the applicator recited in claim 1. Since claims 12 and 13 depend from claim 1, it

Appl. No. 10/755,427
Amendment dated October 27, 2009
Reply to Office Action Mailed September 28, 2009

is respectfully submitted that these claims are in condition for allowance.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Noiles in view of U.S. Patent No. 5,487,500 to Knodel et al. (“Knodel”). The Office Action stated that Noiles discloses the applicator recited in claims 17 and 18 except for a plurality of teeth formed on the mid-section extension and a latch pawl cooperating with the teeth. The Office Action asserted that Knodel discloses a mid-section extension formed with a plurality of teeth and that it would be obvious to a plurality of teeth in the mid-section extension of the lever of Noiles and a corresponding latch pawl as disclosed by Knodel.

As previously discussed, Noiles does not disclose or suggest the applicator recited in claim 1. Adding the mid-section extension and the corresponding latch pawl of Knodel fails to cure the deficiencies of Noiles. Knodel fails to disclose or suggest any additional features that, in combination with Noiles, suggests the applicators recited in claim 1. Since claims 17 and 18 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

As part of the Applicants continuing duty of disclosure, the Applicants are informing the Examiner that U.S. Patent Application Serial Number 11/978,893, a related family application is presently docketed to Examiner Vi X. Nguyen in art unit 3734. Examiner Nguyen has not yet issued an Office Action in connection with this related family application.

In view of the foregoing, reconsideration of the application and allowance of claims 1-26 is earnestly solicited. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

Appl. No. 10/755,427
Amendment dated October 27, 2009
Reply to Office Action Mailed September 28, 2009

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefore.

Respectfully submitted,

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 420
Melville, New York 11747
Tel.: (631) 501-5713
Fax: (631) 501-3526

Dana A. Brussel
Dana A. Brussel
Reg. No. 45,717
Attorney for Applicants

Send correspondence to:
Chief Patent Counsel
Covidien
60 Middletown Avenue
North Haven, Connecticut 06473